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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,468

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EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SUGHRUE.COM  
PPROCESSING@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,468	<b>Applicant(s)</b> IKEDA ET AL.	
	<b>Examiner</b> FRANK D. DUCHENEAUX	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Examiner's Note**

The examiner acknowledges applicants' cancellation of claims 2 and 4.

### ***Response to Amendment***

1. Applicant's arguments, see page 7, filed 7/21/2009, with respect to the objection of the abstract have been fully considered and are persuasive. The objection of the abstract has been withdrawn.

2. Applicant's arguments, see pages 7-8, filed 7/21/2009, with respect to the rejection of claims 1-4 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of claims 1-4 has been withdrawn.

3. Applicant's arguments, filed 7/21/2009, are silent with respect to the objection of claim 4; however, it is acknowledged that claim 4 has been cancelled and the limitations of said claim incorporated into claim 1. The objection of claim 4 has been withdrawn.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 3 and 5-7** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "the surface substrate film is a polyethylene resin film comprising a mixture..." It is noted that the open language associated with the word "comprising" is not supported by the disclosure, which only recites "a mixture composed of.." (see page 5, lines 12 and 17 and page 6, line 1). As such, the above-noted recitation is new matter.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1794

7. **Claims 1, 5 and 7** are rejected under 35 U.S.C. 102(a) as being anticipated by Ukei et al. (US 2005/0058829 A1).

**Regarding claims 1, 5 and 7**, Ukei teaches a pressure-sensitive adhesive tape having a supporting substrate made of a plastic film (surface substrate film) and a PSA layer formed on at least one side of the substrate (abstract), said plastic film made of polyethylene resins such as a mixture comprising a combination of HDPE and LDPE in a weight ratio of HDPE to LDPE of 20/80 to 50/50 (50 to 80 pbw of LDPE to 100 pbw of the HDPE and LDPE mixture) with the HDPE and LDPE having a densities of 0.950 g/cm<sup>3</sup> and 0.929 g/cm<sup>3</sup>, respectively (para 0039) and the plastic film has a thickness of from about 50 to 200 μm (para 0050). Ukei continues teaches that the PSA layer is an acrylic PSA (para 0052), said layer having a thickness of from 5 to 50 μm (para 0055). Ukei also teaches that the plastic film contains additives such as colorants, pigments, dyes and age resistors (para 0040, lines 1-3), said fillers used for, *inter alia*, light resistance in an amount of from 1 to 3 parts by weight based on 100 parts by weight of the resin (para 0041).

Given that the Ukei reference discloses a supporting substrate made of a plastic film of a material and having a thickness identical to that presently claimed, including the same proportion of HDPE and HDPE, it is clear that the supporting substrate made of a plastic film would inherently possess the tensile modulus of elasticity of the surface substrate film of the present invention.

Art Unit: 1794

The recitation in the claims that the surface substrate film having a PSA layer on at least surface is “for adhering onto a motor vehicle wheel” as a “motor vehicle brake disc antirust film” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Ukei et al. reference discloses supporting substrate made of a plastic film and a PSA layer formed on at least one side of the substrate as presently claimed, it is clear that the invention of Ukei et al. would be capable of performing the intended use, i.e. a motor vehicle brake disc antirust film for adhering onto a motor vehicle wheel, presently claimed as required in the above cited portion of the MPEP.

### ***Claim Rejections - 35 USC § 103***

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 1794

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ukei et al. (US 2005/0058829 A1) in view of Endo et al (US 6872447 B1).

10. **Regarding claim 3**, Ukei teaches a pressure-sensitive adhesive tape as in the rejection of claim 1 above. Ukei is silent to an ultraviolet absorber in a proportion of 0.01 to 20 parts by mass relative to 100 parts by mass of a surface substrate film and a spectral transmittance of the surface substrate film in a wavelength region from 200 to 380 nm falls within a range from 0 to 20 %.

However, Endo teaches a surface-protective PSA sheet comprising a three-layered film comprising layer A, wherein layer A contains a polyethylene (column 1, lines 51-56), and wherein layer A contains an ultraviolet absorber in an amount of 0.05 to 0.5 % by weight based on the total weight of the layer A (column 2, lines 17-21). Endo also teaches the ultraviolet stabilizer is Tinuvin 326, which is identical to the stabilizer used in the present invention (column 6, lines 10-11). Endo finally teaches said pressure-sensitive adhesive sheet has excellent weathering resistance to undergo neither chalking nor fracture in the substrate at peeling, even after prolonged outdoor exposure, which develops less corona odor to enable extended operation of applying it, and which can be manufactured inexpensively with reduced manufacturing process (column 1, lines 7-13). The examiner notes that Ukei and Endo teach a substrate comprising the composition, to include the UV stabilizer as presently disclosed and in

Art Unit: 1794

the amounts as presently claimed, and thickness as presently claimed and as such, Ukei and Endo intrinsically provide a substrate having the spectral transmittance as presently claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ukei and Endo references to provide a supporting substrate containing UV blockers, towards a PSA sheet that mitigates the damaging effects of UV wavelengths on both the sheet and an adherend to which the sheet is adhered as in the present invention.

11. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ukei et al. (US 2005/0058829 A1) in view of Watanabe et al (US 5795650).

**Regarding claim 6**, Ukei teaches a pressure-sensitive adhesive tape as in the rejection of claim 1 above. Ukei is silent to an acrylic polymer having a weight-average molecular weight of 500,000 to 1,100,000 crosslinked with a polyisocyanate compound.

However, Watanabe teaches a teaches a pressure sensitive adhesive sheet comprising a PSA having a polymer with a weight-average molecular weight of from 800,000 to 1,800,000 to maintain a firm bonding between the PSA and a base layer (column 4, lines 28-37), said polymer is an acrylic (column 3, lines 42-44) containing carboxylic acid group-containing monomers (column 3, lines 60-62), and said PSA further comprising isocyanate crosslinking agents (column 4, lines 19-22) such as diisocyanate (polyfunctional) (column 8, lines 13-14).



Art Unit: 1794

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ukei and Watanabe references towards a PSA tape comprising polyisocyanate-crosslinked acrylic polymers since it is well known on the art to crosslink acrylic polymers with an isocyanate compound, and said polymer being of a molecular weight as presently claimed towards an adhesive layer with firm bonding between said PSA layer and a base layer as in the present invention.

### ***Response to Arguments***

12. Applicant's arguments, see pages 8-11, dated 7/21/2009, with respect to the rejections of claims 1-3 over Sugino et al. under 35 U.S.C. 102(b) and claims 3-4 over Sugino et al. in view of Endo et al. under 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection. As set forth above, Ukei teaches all the limitations of claims 1, 5 and 7, Ukei et al. in combination with Endo et al. teach all the limitations of claim 3 and Ukei et al. in combination with Watanabe et al. teach all the limitations of claim 6.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1794

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. D. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794